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SOLICITOR

JUN - 4 2004

U.S. PATENT & TRADEMARK OFFICE

THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

In re Application of

W. Roy KNOWLES, M.D.,

Petitioner.

No. \_\_\_\_\_

Petition for  
Writ of Mandamus (28 U.S.C. § 1651(a))

**THE RELIEF SOUGHT**

Petitioner filed a patent application. The Patent Examiner rejected it. Petitioner thus filed an appeal. The Patent Examiner, however, refuses to forward the appeal to the Board of Patent Appeals.

Petitioner thus respectfully requests the Court issue a Writ of Mandamus pursuant to 28 U.S.C. § 1651(a) and FED. R. APP. PROC. Rule 21, requiring the Examiner to forward the pending Appeal Brief to the Board.

**THE ISSUES PRESENTED**

Whether the Court can and should issue a writ of mandamus?

**THE FACTS NECESSARY TO UNDERSTAND THE ISSUES**

We will briefly review the procedural prosecution history to date. (We do not address the substantive merits of the patent application. A complete copy of the prosecution history,

together with all references of record, is included as an Adobe® Acrobat file on a CD-ROM, in the Appendix.)

In examining patent application Serial No. 09/619,142, the U.S. Patent Office issued six OFFICE ACTIONS. Each one raised duplicative rejections which are unsustainable as a matter of law. Accordingly, Petitioner seeks Board review of the Examiner's actions. The Examiner, however, flatly refuses to allow the Board of Patent Appeals & Interferences to review her work.

Thus, Petitioner has to date filed four APPEAL BRIEFS and the Examiner has refused to allow the Board of Patent Appeals & Interferences to review any of these.

Withholding this application from the Board harms Petitioner because it denies Petitioner his Constitutional right to a patent, and the right to appellate review of any decision denying that patent.

Petitioner has therefore petitioned the Examiner's Director, asking him to forward the appeal to the Board. The Examiner's Director, understandably reluctant to have the Examiner's work reviewed by the Board, refused.

#### THE PROSECUTION HISTORY FROM FILING TO THE FIRST APPEAL

Petitioner filed this application on 19 July 2000.

On 31 Oct. 2000, the Examiner mailed the first OFFICE ACTION, rejecting the claims.

On 7 Feb. 2001, Petitioner filed a RESPONSE and a DECLARATION.

On 27 March 2001, Examiner mailed the second OFFICE ACTION. The Examiner reject the claims over art sworn behind in the DECLARATION.

On 26 April 2001 Petitioner filed an APPEAL BRIEF. The Examiner refused to even enter it. On 18 July 2001, Petitioner again filed an APPEAL BRIEF. The Examiner refused to forward it to the Board.

Rather, on Sept. 28<sup>th</sup>, 2001, the Examiner (violating Office procedure for several reasons) issued her third OFFICE ACTION.

On 10 Jan. 2002, Petitioner filed a RESPONSE.

On 9 May 2002, the Examiner mailed her fourth OFFICE ACTION. Troublingly, it recited rejections which had been previously raised, conceded by the Examiner to be unfounded, and withdrawn.

On 29 June 02, Petitioner filed another APPEAL BRIEF.

Within two months after the APPEAL BRIEF is filed, the Examiner must file her EXAMINER'S ANSWER. MANUAL OF PATENT EXAM. PROC. § 1208 (Aug. 2003). If the Examiner does not believe it necessary to file an EXAMINER'S ANSWER, then the Examiner should simply forward the APPEAL BRIEF to the Board. *Cf.* 37 C.F.R. § 1.193(a)(1).

Here, the Examiner ignored the two-month deadline, refused to forward the APPEAL BRIEF to the Board, and refused to do anything *at all* for nearly a year.

On 20 Feb. 03, the Examiner issued another OFFICE ACTION. Troublingly, it recited rejections which had been previously raised, conceded by the Examiner to be unfounded, and withdrawn.

Accordingly, on 29 Mar 2003, Petitioner filed a PETITION asking the Examiner's Director to forward the nine-month old APPEAL BRIEF to the Board.

The Director recognized the rejections articulated in the latest OFFICE ACTION were inappropriate,<sup>1</sup> and that the Examiner had refused to do her job and file an EXAMINER'S ANSWER.<sup>2</sup> The Director, however, concluded that the Examiner's failures were ground to refuse to hear the Appeal.

The Director thus refused to forward the APPEAL BRIEF to the Board. The Director simply invited Petitioner to file yet another APPEAL BRIEF. *See* PETITION DECISION at 4 (22 May 2003).

Fully complying with the Director's request, on 16 July 2003 Petitioner filed another APPEAL BRIEF – the fourth APPEAL BRIEF filed in this case.

To assure that the latest APPEAL BRIEF was actually forwarded to the Board, Applicant contemporaneously petitioned this Court to intercede. The Court noted that Applicant had filed the July 2003 APPEAL BRIEF. In re Knowles, slip op. Misc. 03-738 (1 Aug. 03) (copy enclosed as Exhibit 1). The Court thus declined to intercede - apparently assuming the Examiner would follow Office procedure and forward a properly-raised appeal to the Board.

Applicant filed its fourth APPEAL BRIEF last summer. Since then, the Examiner has refused to do anything on the case *at all*. She has neither provided me with an EXAMINER'S ANSWER, nor forwarded the fourth APPEAL BRIEF to the Board for review, nor issued a NOTICE OF ALLOWANCE.

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<sup>1</sup> The Examiner has failed to adequately "develop the issues involved." PETITION DECISION at 2-3 (22 May 2003).

<sup>2</sup> The Director will not forward the Appeal until "both parties have provided appropriate arguments in the form of an Appeal Brief and Examiner's Answer." PETITION DECISION at 2 (22 May 2003).

Applicant recognizes that this Court is busy addressing more sophisticated issues of Federal jurisprudence, and has limited resources to oversee Patent Office management. Applicant believes, however, that without Court intervention, the Examiner will delay this patent application for an unlimited number of years, and thus deny Applicant its Constitutional right to a patent. Applicant thus respectfully asks the Court intercede and compel the Patent Examiner to do her job.

### **THE REASONS WHY THE COURT SHOULD ISSUE THE WRIT**

The Court can issue this writ (i.e., jurisdiction lay) and should issue this writ (i.e., the remedy is necessary and appropriate). We address each of these two requirements in turn.

#### **THE FEDERAL CIRCUIT CAN ISSUE THIS WRIT BECAUSE IT HAS THE LEGAL POWER TO DO SO**

The Court has jurisdiction to issue a writ of mandamus.

#### **The Federal Circuit Has Jurisdiction**

The Federal Circuit has jurisdiction to review mandamus requests. The Court of Customs & Patent Appeals discussed the Court's jurisdiction to issue mandamus to preserve an applicant's right to appeal in Margolis v. Banner, 599 F.2d 435 (C.C.P.A. 1979) (copy enclosed as Exhibit 2).

In Margolis, the patent examiner rejected the application, and the applicant appealed. In response, the examiner refused to forward the case to the Board of Appeals. Rather, the examiner simply issued another Office Action. The applicant petitioned the Commissioner to reverse the examiner's action. Id. at 439. The Commissioner denied the petition. Id. The applicant then petitioned the C.C.P.A. for a writ of mandamus.

The Court first acknowledged that it lacked appellate jurisdiction to review certain administrative decisions of the Commissioner. The Court found, however, that “the court clearly has the power to issue writs under the All Writs Act in aid of its prospective appellate jurisdiction.” Id. at 440-41. The Court found this jurisdiction extends to “action by the Commissioner or those acting under his authority that would frustrate such prospective appellate jurisdiction.” Id. The Court expressly said that mandamus authority is not confined to the issuance of writs in aid of a jurisdiction already acquired by filing an appeal; rather the Court’s jurisdiction extends to *any* case which is even *potentially* within its appellate jurisdiction. Id. Because the case at hand involved a patent application, the case fell clearly within the potential jurisdiction of the Court.

The Court said it was “particularly noteworthy” that a rejection had been made, but then withdrawn after applicant filed an APPEAL BRIEF. Id. at 442, n.20. The Court recognized that the examiner’s “Withdrawal of the rejection, of course, frustrated the appeal.” Id. The Court noted that the Commissioner’s subsequent denial of the Petition, “precluding petitioners from an appeal to the Board of Appeals from the *de facto* rejection, clearly had the effect of frustrating this court’s prospective appellate jurisdiction over an appeal from a decision of the Board of Appeals.” Id.

The Court thus concluded that the Commissioner’s refusal to forward the APPEAL BRIEF to the Board “prevented an appeal of the examiner’s action to the Board of Appeals from whose decision an appeal might be taken to this court.” Id. at 441. In so doing, the Commissioner denied the applicant his statutory right to appeal. The Court thus found

mandamus jurisdiction appropriate to preserve the Court's own prospective appellate jurisdiction.<sup>3</sup>

*The Federal Circuit Has Exclusive  
Jurisdiction Over This Petition*

The Commissioner has in the past argued that mandamus petitions should be heard by a District Court, rather than an appellate court. The C.C.P.A. has already reviewed this position - and rejected it. The C.C.P.A. said that requiring a District Court to issue the writ "is not consonant with the purposes of the All Writs Act, because it would place in another court the discretionary power to preserve the prospective appellate jurisdiction of this court. Margolis v. Banner, 599 F.2d 435, 443 (C.C.P.A. 1979). Therefore, the Federal Circuit, rather than a District Court, is the appropriate court to issue this writ.

*The Court is Not Reviewing  
a Petition Decision*

In its review of this application last year, the Court expressed some doubt regarding whether the Court has mandamus jurisdiction over this matter. See In re Knowles, slip op. Misc. 03-738 (1 Aug. 03) at 2, fn. \*, citing In re Makari, 708 F.2d 709 (Fed. Cir. 1983).

In Makari, the applicant appealed a decision by the Commissioner on a Petition. In the immediate case, in contrast, Petitioner is not appealing a decision by the Commissioner; rather, Petitioner is appealing *a refusal to decide at all*.

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<sup>3</sup> See also Cook v. Dann, 522 F.2d 1276, 1276 (C.C.P.A. 1975) ("respondents' challenge to our jurisdiction under the All Writs Act (28 U.S.C. 1651(a)) must be rejected"); Weil v. Dann, 503 F.2d 562 (C.C.P.A. 1974); Duffy v. Tegtmeier, 489 F.2d 745 (C.C.P.A. 1974); Loshbough v. Allen, 404 F.2d 1400 (C.C.P.A. 1969); Reddy v. Dann, 529 F. 1347, 1348 (C.C.P.A. 1976) ("our decisions in Duffy and Weil to deny writs were necessarily based on our first finding that we had jurisdiction to issue writs of mandamus").

Furthermore, in Makari, the parties did not dispute that the Board would hear the appeal. The Court thus found no mandamus was in fact required, concluding, "If the board affirms the rejection in whole or in part, Makari may appeal that decision to this court." 708 F.2d at 711. In the immediate case, the Commissioner is refusing to hear Petitioner's appeal at all, frustrating any appeal to this Court.

For the forgoing reasons, the Court can issue the writ. In addition, the Court should issue the writ.

THE COURT SHOULD ISSUE THIS WRIT  
BECAUSE IT IS THE APPROPRIATE  
REMEDY FOR THIS SITUATION

The Court should issue the writ because the right to issuance of a writ is "clear and indisputable" and because Petitioner has no other means of attaining the relief desired. These standards were discussed by the U.S. Supreme Court in Steinmetz v. Allen, 192 U.S. 543 (1904) (copy enclosed as Exhibit 3).

Refusing To Hear An Appeal Is An Abuse  
Of Discretion, For Which The Proper  
Remedy Is A Writ Of Mandamus

Where an examiner refuses to forward an APPEAL BRIEF for review, the appropriate remedy is a writ of mandamus because the right to issuance of a writ is clear and there is no other means of attaining the relief desired. See Steinmetz v. Allen, 192 U.S. 543 (1904) (copy enclosed as Exhibit 3).

In Steinmetz, the patent examiner issued a second rejection, and Steinmetz filed an Appeal Brief. The examiner, however, "refused to answer the appeal and to forward the same with his answer thereto" for review. Id. at 547.



Steinmetz thus petitioned the Commissioner to forward the appeal for review. Id. The Commissioner denied the petition. Id.

The Supreme Court began by reasoning that a patent applicant is entitled to an appeal as a matter of right. Id. at 556. By refusing to forward the appeal for review, the Examiner divests the applicant of this statutory right. The Supreme Court noted that in this situation, if the applicant yields to the demands of the Examiner, the applicant waives his right to appeal, but if the applicant “does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application.” Id. The Supreme Court concluded that “[a] ruling having such effect must be considered as final and appealable.” Id. The Supreme Court thus concluded that the examiner’s refusal to forward the appeal is a decision ripe for court review.

The Supreme Court then turned to the merits of the case. The Supreme Court began by recognizing that the Commissioner has “some discretion” in administering the agency. Id. at 560. The Supreme Court noted, however, that “Some discretion is not an unlimited discretion.” Id. The Supreme Court said that refusing to hear an appeal is not within the discretion of the Commissioner. To the contrary, it is the exact opposite - it is a refusal by the Commissioner to exercise any discretion at all. The Supreme Court said the Commissioner’s refusal to adjudicate the appeal:

is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore; not regulated.

Id. at 560-61. The Supreme Court found that refusing to adjudicate the appeal “precludes the exercise of any judgment” by the Commissioner at all. Id. at 561. The Supreme Court thus

concluded that the Commissioner's refusal to hear the appeal at all, no matter what the applicant might show, is outside the Commissioner's discretion.

Finding an abuse of discretion, the Supreme Court then addressed what kind of remedy is appropriate. The Supreme Court acknowledged that mandamus is an exceptional remedy. Id. at 563. The Court noted, however, that "if an appeal cannot be compelled from the decision of the primary examiner, an applicant is entirely without remedy." Id. at 564. The Supreme Court therefore held that the exceptional remedy of mandamus is appropriate here. Id. at 566.

The Supreme Court's lead has been followed repeatedly where the Commissioner refuses to adjudicate an applicant's appeal. For example, in Margolis v. Banner, 599 F.2d 435, 443 (C.C.P.A. 1979) (copy enclosed as Exhibit 2), the examiner raised a rejection, but then withdrew it after applicant filed an appeal. Id. at 442, n.20. The Court recognized that "Withdrawal of the rejection, of course, frustrated the appeal." Id. The Court noted the examiner's actions, "precluding petitioners from an appeal to the Board of Appeals ... clearly had the effect of frustrating this court's prospective appellate jurisdiction over an appeal from a decision of the Board of Appeals." The Court thus found a writ of mandamus an appropriate remedy "to secure this court's eventual appellate jurisdiction." Id. at 444.

Similarly, in Coe v. Remington Rand, Inc., 84 F.2d 240 (App.D.C. 1936), in response to the eighth (!) office action, the applicant filed an amendment. Id. at 241. The examiner, however, refused to consider it. The court noted that this refusal "did not amount to a rejection of the application, from which appeal might be taken to the proper court." Id. at 242. The examiner's refusal, however, effectively "blocked ... the right of appeal to the Board of Appeals ... so that petitioner was deprived of any right of appeal whatever for the

determination of his rights.” Id. at 242. The court thus concluded that a writ of mandamus is an appropriate remedy.

The Examiner’s Actions Are Both  
“Arbitrary” And “Capricious”

In the immediate case, as in Steinmetz, Margolis, and Remington-Rand, the Examiner has blocked Petitioner’s right to appeal. In contrast to these cases, however, the Examiner in the immediate case has also, *inter alia*, (a) rejected claims based on references which d not qualify as prior art as a matter of law; (b) re-argued rejections previously conceded to be erroneous; (c) re-argued rejections based on “cumulative” art redundant to art previously conceded to not bar the claims; (d) issued contradictory factual findings; (e) refused to produce required evidentiary materials; and (f) willfully ignored express claim limitations. This behavior defines “arbitrary and capricious,” and is arguably even vindictive. It is perfectly clear why the examiner’s Director does not want the Board to review this file. Thus, the immediate case presents an even greater need for Court intervention than did Steinmetz.

Granting The Writ Assures Discipline  
In The Patent Prosecution Process

Granting the requested writ is good policy. The writ will prevent the examiner from forcing Petitioner to repeatedly argue the same issues. Forcing a patent applicant to repeatedly re-litigate the same issues is a “misallocation of resources” to be avoided. *See* Blonder-Tongue, Inc. v. Univ. of Illinois Foundation, 402 U.S. 313 (1971) (permitting a party to repeatedly re-litigate the same issue “reflects either the aura of [a] gaming table or ‘lack of discipline and of disinterestedness’”).

Here, the duplicative and contradictory rejections raised in the six OFFICE ACTIONS in this case waste resources and, a cynic might say, even evidence “lack of discipline” or “lack of disinterestedness.” The Court should not let the patent examination process degenerate into a “gaming table” of unfounded rejections. The Court can prevent this by issuing a writ of mandamus.

Issuing The Writ Will Protect  
The Petitioner And The Public

Given the potentially significant economic effect an issued patent has on the general public, it is in everyone’s interest to assure that prosecution is done competently and disinterestedly. The factual record is complete and needs to be assessed disinterestedly.

The prosecution history already includes perhaps fifty patent and non-patent references. See APPEAL BRIEF page 2, n.1 (July, 2003). The Examiner does not allege any specific shortcoming in the existing factual record (e.g., that the Examiner should have searched this-or-that field of prior art, but erroneously failed to do so). Thus, it appears undisputed that the factual record is complete.

Using this encyclopedic record of art, the Examiner has, in six OFFICE ACTIONS, failed to identify legally-competent reasons to bar the pending claims. Allowing the same examiner to issue an unlimited number of additional OFFICE ACTIONS will not protect Petitioner’s Constitutional right to a patent, nor protect the general public’s interest in assuring that patents issue after a disinterested and competent examination.


In contrast, the public interest will be protected by enabling the Board to apply their expertise to this case. Thus, in granting the writ requested, the Court will protect the public interest by allowing the application to be examined by the Board.

SUMMARY

Enclosed find a Local Rule 30(a)(3)(A) Appendix including a copy of the entire prosecution history (including all references of record), as an Adobe Acrobat® file on CD-ROM.

Respectfully submitted as of 1 June 2004 on behalf of Petitioner by its attorneys,

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By:   
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Exhibits:

In re Knowles, slip op. Misc. 03-738 (1 Aug. 03)  
Margolis v. Banner, 599 F.2d 435 (C.C.P.A. 1979)  
Steinmetz v. Allen, 192 U.S. 543 (1904)

SD:\KnollTech\Hair Loss\Mandamus Brief (May 04).doc

**LOCAL RULE 30(A)(3)(A) APPENDIX**

Prosecution history for serial no. 09/619,142 on CD-ROM



NOTE: Pursuant to Fed. Cir. R. 47.6, this order  
is not citable as precedent. It is a public order.

## United States Court of Appeals for the Federal Circuit

MISCELLANEOUS DOCKET NO. 738

IN RE W. ROY KNOWLES, M.D.,

Petitioner.

ON PETITION FOR WRIT OF MANDAMUS

Before RADER, GAJARSA, and LINN, Circuit Judges.

RADER, Circuit Judge.

### ORDER

W. Roy Knowles, M.D. petitions for a writ of mandamus to (1) direct the Director of the United States Patent and Trademark Office to forward his appeal of the examiner's actions to the Board of Patent Appeals and Interferences or mandate that the Director issue a notice of allowance or (2) have this court adjudicate the substantive merits of his application.

Knowles states that the examiner has issued six office actions, but refuses to "allow the Board of Patent Appeals & Interferences to review her work." Knowles petitioned the Director to have his application forwarded to the Board. In a well-explained decision, the Director informed Knowles of the steps that he must take in order to ready his application for Board review. Knowles was informed that he had to reply to the last office action by either filing an amendment or filing an appeal brief that responded to that office action or stated that he was of the opinion that all issues which should be considered by the Board had been fully developed. We note that Knowles,



just days before filing this petition, did file such an appeal brief.

The traditional use of the writ of mandamus in aid of appellate jurisdiction, 28 U.S.C. § 1651(a), has been to confine a trial tribunal to a lawful exercise of its prescribed jurisdiction or to compel it to exercise its authority when it is its duty to do so. Roche v. Evaporated Milk Ass'n, 319 U.S. 21, 26 (1943). A party who seeks a writ bears the burden of proving that it has no other means of attaining the relief desired, Mallard v. U.S. Dist. Court for the Southern Dist. of Iowa, 490 U.S. 296, 309 (1989), and that the right to issuance of the writ is "clear and indisputable." Allied Chemical Corp. v. Daiflon, Inc., 449 U.S. 33, 35 (1980).

Even assuming that we have mandamus jurisdiction over this matter, we decline to grant Knowles' petition. Knowles' complaints of impropriety are without basis. The Director informed Knowles of the steps he must take to obtain Board review and, indeed, he has taken a first step. Further, Knowles' request to have this court review the merits of his application is wholly inappropriate. Knowles' petition fails to meet either prong of the test for mandamus, i.e., he fails to show that his right to a writ is clear and indisputable and he fails to show that he has no other means to attain the relief desired.

Accordingly,

IT IS ORDERED THAT:

- (1) The petition for writ of mandamus is denied.
- (2) Any appeal filed by Knowles is dismissed.

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See In re Makari, 708 F.2d 709 (Fed. Cir. 1983).

FOR THE COURT

7/30/03  
Date

Randall R. Rader  
Randall R. Rader  
Circuit Judge

cc: J. Mark Pohl, Esq.  
John Whealan, Esq.  
s5

**FILED**  
**U.S. COURT OF APPEALS FOR**  
**THE FEDERAL CIRCUIT**

**AUG - 1 2003**

**JAN HORBALY**  
**CLERK**

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NOTE: Pursuant to Fed. Cir. R. 47.6, this order  
is not citable as precedent. It is a public order.

# United States Court of Appeals for the Federal Circuit

MISCELLANEOUS DOCKET NO. 738

IN RE W. ROY KNOWLES, M.D.,

Petitioner.

ON MOTION

## ORDER

Upon consideration of the motion of W. Roy Knowles, M.D. for clarification of the  
court's August 1, 2003 order,

IT IS ORDERED THAT:

The motion is granted to the extent that it clarifies that the reference to an appeal  
was an appeal to this court not an administrative appeal before the Board of Patent  
Appeals and Interferences.

FOR THE COURT

SEP - 3 2003

\_\_\_\_\_  
Date

*Jan Horbaly* (A.M.)

\_\_\_\_\_  
Jan Horbaly  
Clerk

cc: J. Mark Pohl, Esq.  
John Whealan, Esq.

s5

**FILED**  
U.S. COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

SEP - 3 2003

**JAN HORBALY**  
**CLERK**

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**C**

United States Court of Customs and Patent Appeals.

Geoffrey MARGOLIS, Dean Frederick Rushmore, Richard Tien-Szu Liu, and Charles Hal Anderson, Petitioners,  
v.  
Donald W. BANNER, Commissioner of Patents and Trademarks, Respondent.

**Appeal No. 79-538.**

May 31, 1979.

Petitioners sought issuance of writs of mandamus and prohibition to Commissioner of Patents and Trademarks, with respect to patent application serial No. 690,732. The Court of Customs and Patent Appeals, Miller, J., held that: (1) it had power to issue writs under All Writs Act in aid of its prospective appellate jurisdiction, where ruling of abandonment by Deputy Assistant Commissioner of Patents and Trademarks prevented appeal of examiner's action to Board of Appeals from whose decision an appeal might be taken to the Court and record showed what had been invented by petitioners, what was invented by other applicants and who was prior inventor of respective inventions, and (2) where mandamus was only adequate means available to permit petitioners to obtain review by Board of Appeals of ruling of Deputy and to secure eventual appellate jurisdiction of the Court, the Court would exercise its power to issue writ of mandamus.

Writ of mandamus issued.

West Headnotes

**[1] Federal Courts ⇨524**  
170Bk524 Most Cited Cases

All Writs Act is not independent grant of appellate jurisdiction, thus appellate jurisdiction which the writs are in aid of must have some other basis. 28 U.S.C.A. § 1651(a).

**[2] Patents ⇨113(6)**  
291k113(6) Most Cited Cases

Generally, Court of Customs and Patent Appeals does not have appellate jurisdiction to review decisions of Commissioner of Patents and Trademarks in patent matters, except indirectly with respect to decisions or matters which are ancillary to priority in an interference, but Court has power to issue writs under All Writs Act in aid of its appellate jurisdiction in face of action by Commissioner, or those acting under his authority, that would frustrate such prospective appellate jurisdiction. 28 U.S.C.A. § 1651(a).

**[3] Patents ⇨113(1)**  
291k113(1) Most Cited Cases

Court of Customs and Patent Appeals had power to issue writs under All Writs Act in aid of its prospective appellate jurisdiction, where ruling of abandonment by Deputy Assistant Commissioner of Patents and Trademarks prevented appeal of examiner's action to Board of Appeals from whose decision an appeal might be taken to the court and record showed what had been invented by petitioners, what was invented by other applicants and who was prior inventor of respective inventions. Patent Office Practice Rules, rule 78(c), 35 U.S.C.A. App.; 35 U.S.C.A. §§ 102(g), 103, 141.

**[4] Patents ⇨101(1)**  
291k101(1) Most Cited Cases

Manual of Patent Examining procedure was invalid to extent that it authorized examiner, under threat of abandonment, to require petitioners who applied for patent and whose application incorporated by reference, another application both of which had been assigned to one corporation, to limit claims of the incorporated application, since regulation providing for elimination of conflicting claims from all but one application of same applicant did not provide such authority when applications were from different inventors and owned by common assignee. Patent Office Practice Rules, rule 78(b, c), 35 U.S.C.A. App.

**[5] Federal Courts ⇨524**  
170Bk524 Most Cited Cases

Authority under All Writs Act is not confined to issuance of writs in aid of jurisdiction already acquired by appeal, but extends to those cases which are within court's appellate jurisdiction although no appeal has been perfected. 28 U.S.C.A. § 1651(a).

**[6] Patents ⇨113(1)**  
291k113(1) Most Cited Cases

Where mandamus was only adequate means available to permit petitioners to obtain review by Board of Appeals of ruling of Deputy Assistant Commissioner for Patents that petitioner's application had become abandoned and to secure eventual appellate jurisdiction of Court of Customs and Patent Appeals, court would exercise its power to issue writ of mandamus and petitioners would not be required to revive their application, a useless act. 35 U.S.C.A. §§ 102, 102(g), 103; Patent Office Practice Rules, rules 137, 201(c), 35 U.S.C.A. App.; 28 U.S.C.A. § 1651(a).

\*436 William H. Vogt III, New York City (Watson, Leavenworth, Kelton & Taggart, New York City), attys. of record, for petitioners; Morris N. Reinisch, New York City, of counsel.

Joseph F. Nakamura, Washington, D.C., for the Commissioner of Patents, Jere W. Sears, Washington, D.C., of counsel.

Before MARKEY, Chief Judge, and RICH, BALDWIN, LANE [FN\*] and MILLER, Judges.

FN\* Judge Lane took part in the consideration and decision of this matter but died before the decision was announced.

MILLER, Judge.

Petitioners seek issuance of writs of mandamus and prohibition to the Commissioner of Patents and Trademarks. Specifically, petitioners request this court to:

issue a writ of mandamus directing the Commissioner to rescind and set aside the December 20, 1978 ruling of his delegate, William Feldman, Deputy Assistant Commissioner \*437 for Patents . . . that "this application became abandoned as of June 3, 1978";

issue a writ of prohibition restraining the Commissioner, and those acting under his authority, from giving effect to the course of action set forth in the November 15, 1978 decision of his delegate, Herbert S. Vincent, Director of Patent Examining Group 170 . . . , Viz., that under MPEP 804.03, "this application will be held to be abandoned if proper response to the (Examiner's) requirement is not made"; and

grant such other and further relief as to this Court may seem just and proper in aid of preserving its appellate jurisdiction.

#### Background

To fully appreciate petitioners' grievance, familiarity with the prosecution history of their application is required. The application [FN1] describes a process for the decaffeination of vegetable material such as roast coffee, green coffee, and tea, by contacting the vegetable material with a fatty material such as safflower oil. Petitioners disclose that if an Aqueous extract of the vegetable material is held in contact with the fatty material at a temperature of 65o C or above (range of 65o C-150o C is disclosed), the rate of transfer of caffeine from the aqueous extract to the fatty material is increased and the ease of separation of the two liquid phases is facilitated all without adverse flavor effects. Petitioners' application incorporates by reference United States patent application serial No. 605,717 of Pagliaro et al., filed August 18, 1975, now abandoned in favor of continuation-in-part application serial No. 742,094, filed November 16, 1976.[FN2] The later application claims the broad invention (no temperature specified, as such) of contacting a vegetable material, in either an aqueous extract or solid form, with a fatty material to effect decaffeination.

With an Aqueous extract a preferred contact temperature range of 0o C-50o C is claimed, and excessively high temperatures are avoided. When a Solid vegetable material is used, temperatures of 50o C-120o C are claimed. In their petition before us, petitioners describe their invention as "a further advance in the art and an improvement over the basic invention claimed by Pagliaro et al." [FN3]

FN1. Application serial No. 690,732, filed May 27, 1976.

FN2. This application has been on appeal to the United States Patent and Trademark Office ("PTO") Board of Appeals since July 10, 1978. The applications of petitioners and Pagliaro et al. are assigned to Societe d' Assistance Technique pour Produits Nestle, S.A., a Swiss corporation.

FN3. Our review of the file wrapper indicates that petitioners, from the beginning of prosecution, characterized their invention as an improvement over the basic invention claimed by Pagliaro et al. As exemplified in their Jepson-type claims referring to the "improvement," this clearly says that their invention was Subsequent in time to the invention of Pagliaro et al.

In the first office action, the examiner rejected petitioner's claims under 35 U.S.C. s 103 (based on 35 U.S.C. s 102 (g) ) on, Inter alia, the disclosure of then copending Pagliaro et al. application serial No. 605,717. Petitioners responded by arguing that the disclosure of a pending application is Not available as citable prior art under 35 U.S.C. s 102(g). Unpersuaded, the examiner substantially repeated the rejection in a second office action, this time relying on the disclosure of Pagliaro et al. application serial No. 742,094, his application serial No. 605,717 having been abandoned. The examiner ruled that the different inventive entities of application serial No. 742,094 and the instant application "are claiming a single inventive concept including variations of the same concept each of which would be obvious in view of the other," and, for the first time, made a request which is the genesis of the petition before us:

Specifically applicants claim in 690,732 decaffeinating a caffeine containing extract of vegetable material with a liquid water immiscible fatty material where the phases of fatty material and aqueous extract are maintained in contact at 65o C or above, whereas in application Serial \*438 No. 742,094 applicant recites contacting a caffeine containing composition with a liquid water immiscible fatty material at a temperature between 50o C and 120o C. The composition is defined as an aqueous extract of tea, of roast coffee, etc. Accordingly in accordance with MPEP 804.03 ([FN4] ) Since in the Examiner's opinion there are conflicting claims in the case, the assignee is

called on to state which entity is the prior inventor of the subject matter and to limit the claims of the other application accordingly. (Emphasis added.)

FN4. The Manual of Patent Examining Procedure ("MPEP") 804.03, which is based on 37 CFR 1.78(c) (note 8, *Infra*), provides, in pertinent part: 804.03 Terminal Disclaimer Not Applicable Commonly Owned Cases of Different Inventive Entities (R-53)

In view of 35 U.S.C. 135, it is necessary to determine priority of invention whenever two different inventive entities are claiming a single inventive concept, including variations of the same concept each of which would be obvious in view of the other. This is true regardless of ownership and the provision of 37 CFR 1.201(c) that interferences will not be declared or continued between commonly owned cases unless good cause is shown therefor. A terminal disclaimer can have no effect in this situation, since the basis for refusing more than one patent is 35 U.S.C. 102 or 103, and is not connected with any extension of monopoly.

Accordingly, the assignee of two or more cases of different inventive entities, containing conflicting claims must maintain a line of demarcation between them. If such a line is not maintained, the assignee should be called on to state which entity is the prior inventor of that subject matter and to limit the claims of the other application accordingly. If the assignee does not comply with this requirement, the case in which the requirement to name the prior inventor was made will be held abandoned.

The response to the examiner's request was due on June 2, 1978, and petitioners responded on that date. They argued, as they had previously, that the disclosure of a pending application is not available as citable prior art under 35 U.S.C. s 102(g); further that there were no conflicting claims since their application claimed the use of an aqueous extract of vegetable material with a contact temperature of at least about 65o C; whereas, contrary to the examiner's interpretation, serial No. 742,094 disclosed that when aqueous extracts are used, contact temperatures should not exceed 50o C. They also pointed out that, contrary to the examiner's interpretation, only when the vegetable material is solid is the contact temperature to be between 50o C and 120o C. With respect to the examiner's request, petitioners stated:

The Examiner's assertion of applicability of MPEP 804.03 is misplaced, and is traversed. A reading of the claims in the respective applications shows that there are no conflicting claims, and that the two applications are indeed directed to distinct and different inventions,

claimed by different inventive entities. The claims of the two applications have been and are limited to the respective inventive contributions. The applicants in Serial No. 742,094 are the inventors of the subject matter claimed therein; and the applicants in the present application are the inventors of the subject matter claimed herein.

Subsequently, on June 30, 1978, petitioners filed a Notice of Appeal on the 35 U.S.C. s 103 rejection, based on 35 U.S.C. s 102(g), to the Board of Appeals.

In a third office action dated August 8, 1978, which was made final, the examiner withdrew the rejection under 35 U.S.C. s 103, apparently agreeing with petitioners' arguments that under the prevailing case law a pending application is not citable as prior art for purposes of 35 U.S.C. s 102(g). [FN5] However, he maintained his position that petitioners' claims and those in serial No. 742,094 were directed to "a single inventive concept including variations thereof each (of) which would be obvious in view of the others." Repeating his prior request, the examiner stated:

FN5. Although the examiner also made a 35 U.S.C. s 112 rejection, as a result of a personal interview with counsel for petitioners, this rejection was withdrawn.

(A)pplicants are once again called on to state Which entity is the prior inventor of the subject matter and to limit the claims \*439 of the other application accordingly. If the assignee does not comply with this requirement, this case will be held to be abandoned as per MPEP 804.03. (Emphasis added.)

In addition, the examiner said that the Claims of Pagliaro et al.'s application (serial No. 742,094) should be amended to expressly exclude petitioners' claimed temperature range when an aqueous extract is used. Thus, at this stage of prosecution, no rejections, labelled as such, remained. Accordingly, on or about August 15, 1978, petitioners withdrew their appeal to the Board of Appeals.

Having failed to persuade the examiner that he was in error, petitioners then petitioned the Commissioner pursuant to CFR 1.181(a) [FN6] and 1.183. [FN7] The decision with respect to that part of the petition relating to 37 CFR 1.181(a) was delegated to the Director of Patent Examining Group 170. The Group Director denied that part of the petition in a ruling dated November 15, 1978:

FN6. S 1.181 Petition to the Commissioner.

FN(a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the ex parte prosecution of an application which



is not subject to appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

FN7. S 1.183 Suspension of rules.

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

It is apparent from a review of the examiner's action that he has carefully considered applicants' arguments in this matter. There is no clear error in the examiner's conclusion that a line of demarcation has not been maintained between the claims of the commonly assigned applications. Moreover, assuming arguendo that the assignee is of the correct opinion that no conflict exists, there is no provision that enables the assignee to delay naming the prior inventor. Thus it is not seen that the examiner has abused his authority in making the requirement and the petition is Denied.

The consequences of failing to comply with this requirement are clearly identified in M.P.E.P. 804.03 and this application will be held to be abandoned if proper response to the requirement is not made. The period for response is extended to expire FOUR MONTHS from August 8, 1978, the date of the final rejection.

It is noted that the avenue of appeal becomes open in the event applicant should disagree with any rejection based on the election. (Emphasis in original.)

The portion of the petition relating to 37 CFR 1.183, which was a request to waive 37 CFR 1.78(c).[FN8] was denied on December 20, 1978, by the Deputy Assistant Commissioner for Patents, who stated:

FN8. 37 CFR 1.78(c) reads:

Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, the assignee may be called upon to state which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should be declared or that no conflict exists in fact.

The provisions of 37 CFR 1.183 permit the Commissioner to waive or suspend any requirement of the regulations which is not a requirement of the statutes in an extra-ordinary situation when justice requires. Since the assignee has the unique knowledge of invention dates

pertaining to conflicting claims in commonly assigned applications, the consequences associated with withholding this information, which is relevant to a determination of patentability in those applications, are calculated to induce compliance with the requirement. As such, this is not deemed an extraordinary situation wherein justice requires waiver or suspension of the rules.

\*440 The Deputy Assistant Commissioner did not stop there. Notwithstanding the fact that the examiner had issued a third and final office action and that the Group Director, who decided the portion of the petition relating to 37 CFR 1.181(a), had extended the period to respond to that office action, the Deputy Assistant Commissioner ruled that petitioners' application became abandoned as of June 3, 1978. He reasoned that since petitioners' response to the second office action [FN9] failed to specify who was the prior inventor, as requested by the examiner, and since that failure was not inadvertent, the application became abandoned for failure to prosecute by virtue of 35 U.S.C. s 133 [FN10] and 37 CFR 1.135.[FN11] The petition before us followed.

FN9. As discussed Supra, the response to this office action was due on June 2, 1978, and petitioners responded on that date.

FN10. S 133. Time for prosecuting application

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

FN11. S 1.135 Abandonment for failure to respond within time limit.

(a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (s 1.136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide

attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See s 1.7.)

#### OPINION

[1][2][3] The threshold question is whether this court has the Power to issue the requested writs, as distinguished from the question of whether the court, in its discretion, should exercise that power. Cf. *La Buy v. Howes Leather Co.*, 352 U.S. 249, 77 S.Ct. 309, 1 L.Ed.2d 290 (1957); *Roche v. Evaporated Milk Ass'n*, 319 U.S. 21, 63 S.Ct. 938, 87 L.Ed. 1185 (1943); *Reddy v. Dann*, 529 F.2d 1347, 188 U.S.P.Q. 644 (CCPA 1976). The solicitor's position is that this court lacks such power since it has no jurisdiction, by appeal or otherwise, to review a decision by the Commissioner holding an application abandoned. However, under 28 U.S.C. s 1651(a), [FN12] the All Writs Act, this court has the power to issue all writs necessary or appropriate "in aid of" its appellate jurisdiction. *Loshbough v. Allen*, 404 F.2d 1400, 56 CCPA 913, 160 U.S.P.Q. 204 (1969). Since the All Writs Act is not an independent grant of appellate jurisdiction, the appellate jurisdiction for which the writs are "in aid of" must have some other basis. See *Roche v. Evaporated Milk Ass'n*, supra, 319 U.S. at 23-26, 63 S.Ct. 938; *Goodbar v. Banner*, No. 79-555, 599 F.2d 431 (Cust. & Pat.App.1979); *Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 U.S.P.Q. 641 (CCPA 1979). While it is generally true that this court does not have appellate jurisdiction to review decisions of the Commissioner in patent matters, *In re Wiechert*, 370 F.2d 927, 54 CCPA 957, 152 U.S.P.Q. 247 (1967), except indirectly with respect to decisions on matters which are ancillary to priority in an interference, See *Godtfredsen v. Banner*, No. 79-514, 598 F.2d 589 (Cust. & Pat.App.1979), and *Duffy v. Tegtmeyer*, 489 F.2d 745, 180 U.S.P.Q. 317 (CCPA 1974), the court clearly has the power to issue writs \*441 under the All Writs Act in aid of its prospective appellate jurisdiction in the face of action by the Commissioner or those acting under his authority that would frustrate such prospective appellate jurisdiction. See *Roche v. Evaporated Milk Ass'n*, supra, 319 U.S. at 25-26, 63 S.Ct. 938; *McClellan v. Carland*, 217 U.S. 268, 280, 30 S.Ct. 501, 54 L.Ed. 762 (1910); *National Farmers' Organization, Inc. v. Oliver*, 530 F.2d 815, 816-17 (8th Cir. 1976); *Environmental Defense Fund, Inc. v. Ruckelshaus*, 142 U.S.App.D.C. 74, 82-3, 439 F.2d 584, 592-93 (1971). As developed hereinafter, the ruling of abandonment by the Deputy Assistant Commissioner was such an action in that

it prevented an appeal of the examiner's action to the Board of Appeals from whose decision an appeal might be taken to this court.[FN13]

#### FN12. S 1651 Writs

(a) The Supreme Court and all courts established by Act of Congress may issue all writs necessary or appropriate in aid of their respective jurisdictions and agreeable to the usages and principles of law.

FN13. This does not mean that every ruling of abandonment will support the issuance of a writ of mandamus or prohibition. Only under extraordinary circumstances or when there is a clear abuse of discretion will this court issue such a writ.

As related above, the examiner requested, under threat of abandonment of the application, that petitioners state which inventive entity, petitioners or Pagliaro et al., "is the prior inventor of the subject matter (of allegedly conflicting claims)," [FN14] and that petitioners' assignee limit the claims of the other application accordingly.[FN15] 37 CFR 1.78(c) sets forth the requirement that petitioners state "which named inventor (as between Pagliaro et al. and petitioners) is the prior inventor.[FN16] The regulation does not provide that, upon threat of abandonment of their application, petitioners may be required to state which inventive entity is the prior inventor of the subject matter of conflicting claims, MPEP 804.03 to the contrary notwithstanding. If petitioners did not believe there were conflicting claims, their only available response was to state who is the prior inventor of their respective inventions. Indeed, 37 CFR 1.78(c) clearly provides that petitioners have the right to explain "that no conflict exists in fact." They exercised this right by traversing the examiner's assertion of the applicability of MPEP 804.03.

FN14. Although the regulations do not define "conflicting claims," MPEP 804.03 uses this term to describe "a single inventive concept (claimed by different inventive entities), including variations of the same concept each of which would be obvious in view of the other." Since the examiner's request was based upon MPEP 804.03, we will accept this as a definition of "conflicting claims" for purposes of this appeal. However, it is unnecessary for us to decide whether, in fact, there are conflicting claims.

Although the examiner stated in his second office action that "there are conflicting claims in the (petitioners') case" and in his third office action that petitioners' claims and the claims of Pagliaro et al. are directed to "a single inventive concept including (obvious) variations thereof," he did not

specify the "subject matter" (nor did he specify which of petitioners' claims conflicted with the claims of the Pagliaro et al. application) for which petitioners were to name the prior inventor. It is incumbent upon an examiner in making a request pursuant to 37 CFR 1.78(c) to specify the "subject matter" so that an applicant Can name the prior inventor thereof.

FN15. In the third office action, the examiner suggested specific changes in the claims of the Pagliaro et al. application that he regarded as essential.

FN16. 37 CFR 1.78(c) was promulgated for the purpose of providing a "basis for requiring a determination of priority without an interference by the common owner of a plurality of applications, or patent and applications, containing conflicting claims." 36 Fed.Reg. 7312 (1971).

Petitioners responded to the requirement of 37 CFR 1.78(c) by stating that "the applicants in Serial No. 742,094 are the inventors of the subject matter claimed therein; and the applicants in the present application are the inventors of the subject matter claimed herein." In the context of petitioners' claims to an "improvement" over the basic Pagliaro et al. invention, their response to the examiner clearly was that their invention was Later than the invention of "(t)he applicants in Serial No. 742,094," and the requirement of 37 CFR 1.78(c) was satisfied. The examiner's 35 U.S.C. s 103 rejection (based on 35 U.S.C. s 102(g)) [FN17] in his \*442 first office action demonstrates his understanding that petitioners' invention was later, as does his repetition of the rejection in his second office action. Also, in his first office action, the examiner referred to certain statements in petitioners' specification as evidence of a concession that the Pagliaro et al. "application 605,717 . . . (is considered) to be prior art."

FN17. We express no opinion regarding the propriety of a 35 U.S.C. s 103 rejection based upon a pending application as prior art under 35 U.S.C. s 102(g), the issue not being before us.

Essentially, the subject matter of petitioners' allegedly conflicting claims is a process for decaffeination of coffee in an aqueous solution at a temperature of at least 65o C. Pagliaro et al., in their application No. 742,094, now pending before the Board of Appeals, claims such a process (a) broadly, with no temperature specified, as such, and (b) preferably, with the temperature not in excess of 50o C. The Solicitor suggests that petitioners, in their response to the examiner's request, should have assumed that their claims were in "conflict" with the claims of Pagliaro et al. and then, on this assumption, should have named the first inventor of

those conflicting claims. Such a suggestion indicates that the Solicitor fails to appreciate that petitioners Did name the first inventor. Petitioners stated that they were the first to invent the subject matter of Their claims (deemed "conflicting" by the examiner). However, they could not truthfully state that Pagliaro et al. were the "prior inventor" of the Whole subject matter of petitioners' allegedly conflicting claims.[FN18] Moreover, under 37 CFR 1.78(c), petitioners had the right, which they properly exercised, to traverse the examiner's assertion of the applicability of MPEP 804.03.

FN18. Such a statement would have been contrary to their oath. Moreover, to require a response wherein petitioners, in one breath, would make a statement that is clearly untrue on the record before us, and, in the next breath, would deny that statement, would be absurd.

Because the record in this case shows (a) what was invented by one applicant (petitioners), (b) what was invented by the other applicant (Pagliaro et al.), and (c) who was the prior inventor of the respective inventions, the requirement for information under 37 CFR 1.78(c) was satisfied. Thereafter, the examiner had all of the information needed to assert a 35 U.S.C. s 103 rejection, based upon 35 U.S.C. s 102(g), if he concluded that the subject matter of petitioners' claims would have been an obvious variation of the subject matter of the claims of the Pagliaro et al. application.[FN19] The correctness of such a rejection, as noted by the Group Director in his decision upholding the examiner's request, would be reviewable on appeal to the Board of Appeals.[FN20] If the board upheld the examiner's decision, this would be reviewable by this court under 35 U.S.C. s 141.

FN19. For the examiner to have required a binding admission that there are conflicting claims and (under the above-cited definition of "conflicting claims" by MPEP 804.03) that petitioners' claims are obvious variations over the claims of Pagliaro et al. would have been beyond his authority under 37 CFR 1.78(c).

FN20. It is particularly noteworthy that such a rejection (the very rejection which the Group Director indicated would be appealable) had been made, but then withdrawn after petitioners responded to the examiner's request (in the second office action) and filed an appeal of that rejection with the Board of Appeals. Withdrawal of the rejection, of course, frustrated the appeal.

Under these circumstances, the examiner's citation of MPEP 804.03 as authority to authorize abandonment of petitioners' application was misplaced.

[4] Moreover, we are persuaded that the examiner improperly required, under threat of abandonment per MPEP 804.03, that petitioners' assignee limit the claims of the Pagliaro et al. application. See *In re Mott*, 539 F.2d 1291, 190 U.S.P.Q. 536 (CCPA 1976). Although 37 CFR 1.78(b) provides for "elimination" of conflicting claims from all but one application of the same applicant, 37 CFR 1.78(c) provides no such authority when the applications are from different inventors and are owned by a common assignee,[FN21] and to the extent that \*443 MPEP 804.03 undertakes to authorize such action, it is invalid.

FN21. Thus, when the claims of a subsequent application conflict with those of an earlier application of the same inventor, such conflicting claims (which would have been obvious variations over the claims of the earlier application) may be inserted into the earlier application; however, that option is not available when the two applications have different inventors.

[5] Accordingly, we conclude that the examiner's demands, under threat of abandonment, that petitioners do more than they did amount to a De facto rejection of petitioners' claims.[FN22] See *In re Haas*, 486 F.2d 1053, 179 U.S.P.Q. 623 (CCPA 1973); Cf. *In re Priest*, 582 F.2d 33, 199 U.S.P.Q. 11 (CCPA 1978). The subsequent ruling of abandonment by the Deputy Assistant Commissioner, precluding petitioners from an appeal to the Board of Appeals from the De facto rejection, clearly had the effect of frustrating this court's prospective appellate jurisdiction over an appeal from a decision of the Board of Appeals. As the Supreme Court stated in *Roche v. Evaporated Milk Ass'n*, supra, 319 U.S. at 25, 63 S.Ct. at 941:

FN22. In his summary of an interview with petitioners' lawyer subsequent to the third and final office action, the examiner wrote: "Exr (Examiner) was of the opinion that cls (claims) of this case ➡ App'n Ser N 742094 were not distinguishable ➡ there was no clear line of demarcation." Thus, the only apparent basis for such a rejection is that petitioners' claims would have been obvious over those of the Pagliaro et al. application. The question of prior inventorship was, ostensibly, fully resolved to the satisfaction of the examiner.

(A)uthority is not confined to the issuance of writs in aid of a jurisdiction already acquired by appeal but extends to those cases which are within its appellate jurisdiction although no appeal has been perfected. Otherwise the appellate jurisdiction could be defeated and the purpose of the statute authorizing the writ thwarted by unauthorized action of the district court obstructing the appeal. (Citations omitted.)

*Accord*, *National Farmers' Organization, Inc. v. Oliver*, supra At 816; *International Business Machines Corp. v. Edelstein*, 526 F.2d 37, 40-41 (2d Cir. 1975).

[6] The remaining question is whether this court should exercise its power to issue the writs petitioners seek, recognizing that they are to be issued only in extraordinary circumstances when no meaningful alternatives are available. *Kerr v. United States District Court*, 426 U.S. 394, 403, 96 S.Ct. 2119, 48 L.Ed.2d 725 (1976). As to the requested writ of mandamus to rescind and set aside the December 20, 1978, ruling of the Deputy Assistant Commissioner for Patents that petitioners' application became abandoned as of June 3, 1978, we are persuaded that no other adequate means is available that would permit petitioners to obtain review by the Board of Appeals and to secure this court's eventual appellate jurisdiction. We agree with petitioners that the Solicitor's suggestion that they should first petition the Commissioner to revive their application is tantamount to having petitioners do a useless act. [FN23]

FN23. 37 CFR 1.137 provides for revival of an abandoned application as follows:

An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the Delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee. (Emphasis added.)

As related above, the Deputy Assistant Commissioner determined that petitioners' failure to specify who was the prior inventor was not inadvertent, so it could not be shown that the "delay was unavoidable" for purposes of 37 CFR 1.137.

The Solicitor also suggests that petitioners pursue their rights in an appropriate district court so that eventual appeal to the Board of Appeals and then to this court would be available. Although this could be done, such an alternative is not consonant with the purposes of the All Writs Act, because it would place in another court the discretionary power to preserve the prospective appellate jurisdiction of this court sought by petitioners. See *Roche v. Evaporated Milk Ass'n*, supra; *Maryland v. Soper*, 270 U.S. 9, 30, 46 S.Ct. 185, 70 L.Ed. 449 (1926); \*444 *World-Wide Volkswagen Corp. v. United States International Trade Commission*, 414 F.Supp. 713, 716, 191 U.S.P.Q. 626, 628 (D.D.C.1976). Moreover, the alternative would also entail an unnecessary expenditure of scarce judicial resources.

Accordingly, we are satisfied that a writ of mandamus to

vacate the ruling of abandonment should be issued, and the writ is, hereby, issued.

As to the requested writ of prohibition restraining the Commissioner from giving effect to the course of action established by the November 15, 1978, decision of the Director of Patent Examining Group 170, such a writ appears unnecessary in view of our decision that a "proper response" to the examiner's requirement for information under 37 CFR 1.78(c) has been made, thus rendering moot any proposed action for failure to properly respond.

WRIT OF MANDAMUS GRANTED.

599 F.2d 435, 202 U.S.P.Q. 365

END OF DOCUMENT

# H

Supreme Court of the United States

UNITED STATES *ex rel.* CHARLES P. STEINMETZ, *Plff.*  
*in Err.*,

v.

FREDERICK I. ALLEN, Commissioner of Patents.

No. 383.

Argued January 12, 13, 1904.

Decided February 23, 1904.

IN ERROR to the Court of Appeals of the District of Columbia to review a judgment which affirmed the judgment of the Supreme Court of that District dismissing a petition for mandamus to compel a Commissioner of Patents to require the primary examiner to forward an appeal to the board of examiners-in- chief. *Reversed*, with directions to reverse the judgment of the Supreme Court, and to direct that court to grant the writ of mandamus.

See same case below, 31 Wash. L. Rep. 358.

West Headnotes

## Mandamus ⇨86

250k86 Most Cited Cases

Mandamus lies to compel the Commissioner of Patents to require the primary examiner to forward to the board of examiners in chief the appeal to which an inventor is entitled, under Rev.St.U.S. § 4909, 35 U.S.C.A. § 57, upon a second rejection of any of his claims by the primary examiner, where such examiner has twice denied his right to unite in one application process and apparatus claims which are essentially the same invention.

## Federal Courts ⇨491

170Bk491 Most Cited Cases

(Formerly 106k388)

A suit in which the validity of a regulation established by the Commissioners of Patents, under the authority of Rev.St.U.S. § 482, 35 U.S.C.A. § 7, for the conduct of proceedings in the Patent Office, is assailed, is one in which there is drawn in question the validity of "an authority exercised under the United States" within the meaning of Act Feb. 9, 1893, c. 74, § 8, 27 Stat. 436 giving an appeal in such cases from the final judgment or decree of the Court of Appeals of the District of Columbia to the federal Supreme Court.

## Patents ⇨98

291k98 Most Cited Cases

So far as rule 41 of the Patent Office rules of practice prevents an inventor from uniting in one application process and apparatus claims which are essentially the same invention, it is invalid as an abuse of the discretion vested in the Patent Office to permit or deny a joinder of inventions.

## Patents ⇨107

291k107 Most Cited Cases

An inventor is not estopped from insisting upon his application for a patent in which were united process and apparatus claims for essentially the same invention by requiring his process claims to be placed in interference with those of an existing patent after receiving a letter from the primary examiner permitting the retention of the process and apparatus claims pending the determination of the interference, but stating that the acceptance of an interference on one of the process claims would be held by the office to be an election of the prosecution of such claims, and further prosecution of the apparatus claims would not be permitted.

**\*\*419 \*549 Messrs. Frederick h. Betts and Melville Church** for plaintiff in error.

**\*553 Assistant Attorney General McReynolds, Solicitor General Hoyt, and Mr. John M. Coit** for defendant in error.

**\*\*417 Statement by Mr. Justice McKenna:**

**\*543** This is a petition in mandamus filed in the supreme court of the District of Columbia to compel the Commissioner of **\*544** Patents to require the primary examiner to forward an appeal, prayed by the petitioner, to the board of examiners-in-chief, to review the ruling of the primary examiner requiring petitioner to cancel certain of his claims in his application for motor meters.

The supreme court dismissed the petition, and its action was affirmed by the court of appeals. This writ of error was then sued out.

The decision of the primary examiner was based upon rule 41 of practice in the Patent Office, and the case involves the validity of the rule under the patent laws.

The petitioner filed an application in the Patent Office, November 21, 1896, for a patent for 'certain new and useful improvements in motor meters.' He expressed his invention in thirteen claims. They are inserted in the margin.  
[FN<<dagger>>]

**\*\*418 \*545** The first six were held by the primary examiner to be claims for a process; the balance of the claims to be for an apparatus; and on the 15th of May, 1900, ordered that the latter, that is, claims 7, 8, 9, 10, 11, 12, and 13, be canceled

from the application. In other words, he required a division between the process claims and the apparatus claims, in accordance with rule 41. That rule is as follows:

**\*546** '41. Two or more independent inventions cannot be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result, they may be claimed in one application.

'Claims for a machine and its product must be presented in separate applications.

'Claims for a machine and the process in the performance of **\*547** which the machine is used must be presented in separate applications.

'Claims for a process and its product may be presented in the same application.'

Petitioner persisted in his application as filed, and the primary examiner repeated his order for a division of the claims. Petitioner regarded such order as 'a second final rejection' of his claims to the apparatus, and appealed therefrom to the board of examiners-in-chief. The primary examiner refused to answer the appeal and to forward the same with his answer thereto and the statements required by the rules of the Patent Office. Thereafter, on the 20th of August, 1900, petitioner petitioned the Commissioner of Patents to direct the primary examiner to forward said appeal, which petition was denied. It was repeated to the present Commissioner, defendant in error, **\*\*419** and by him denied on the 7th of February, 1902.

These facts constitute petitioner's claim to relief.

The answer of the respondent asserts the validity of rule 41, justifies the action of the Patent Office, alleges that petitioner is estopped from contesting the orders of the primary examiner, and also alleges that those orders 'did not involve the rejection of any claim or an action upon the merits of any claim made by the relator,' as provided in rule 13, and that 'the statutes and rule 133 of the rules of practice do not provide for an appeal to the examiners-in-chief from an examiner's requirement for division, and the examiners-in-chief have no jurisdiction to pass upon the question whether or not division should be required.'

The answer presents also the following facts: Prior to making the order of May 15, 1900, to wit, on October 9, 1899, the primary examiner wrote a letter to petitioner regarding the division of the process claims and the apparatus claims, in accordance with rule 41, before further action would be given upon the merits of the case.

Petitioner replied December 15, 1899, requesting 'that the

**\*548** requirement for division be waived for the present,' in order that his process claims be placed in interference with the claims of a patent to one Duncan. To this request the examiner answered:

'Pending the determination of the interference, applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and the further prosecution of the apparatus claims in this application will not be permitted.'

Petitioner replied January 19, 1900, urging that the interference be declared, and on February 7, 1900, it was declared and decided in favor of petitioner. After the decision the examiner wrote the letter of May 15, 1900. These proceedings, respondent contends, constitute an estoppel.

The first ruling of the Commissioner of Patents upon the petition to require the primary examiner to respond to petitioner's appeal was as follows:

'Where applicant does not care to comply with the examiner's requirements in a matter of division such as is here involved, it has been the practice for the past thirty years to treat the question, not as one of merits, and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice. This petition is denied.'

The second order of the Commissioner, respondent, after reciting certain of the facts, concluded as follows:

'The requirement for division is purely a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure, or of the manner of securing the protection, which is in controversy, and not the right of the applicant to a patent upon any of the claims presented.

**\*549** 'The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief, and although it is a general rule of law that the appellate tribunal is the one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and

proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon that question in the first instance.

'The petition is denied.'

**\*555** Mr. Justice **McKenna**, after stating the case as above, delivered the opinion of the court:

1. The jurisdiction of this court to review the judgment of the court of appeals is questioned. There is no money in dispute nor anything to which a pecuniary value has been given. Jurisdiction is claimed under the clause of § 8 of the act of February 9, 1893 [27 Stat. at L. 436, chap. 74 U. S. Comp. Stat. 1901, p. 573], which gives an appeal to this court from the final judgment or decree of the court of appeals in cases in **\*556** which there is drawn in question the validity of 'an authority exercised under the United States.'

By § 483 of the Revised Statutes (U. S. Comp. Stat. 1901, p. 272), the Commissioner of Patents, subject to the approval of the Secretary of the Interior, is empowered to establish from time to time regulations not inconsistent with law, for the conduct of **\*\*420** proceedings in the Patent Office. The Commissioner of Patents, exercising the power conferred, established, among other rules of practice, rule 41. It thereby became a rule of procedure, and constituted, in part, the powers of the primary examiner and Commissioner. In other words, it became an authority to those officers, and, necessarily, an authority 'under the United States.' Its validity was and is assailed by the plaintiff in error. We think, therefore, we have jurisdiction, and the motion to dismiss is denied.

2. The issue is well defined between the parties, both as to the right and remedy, in the Patent Office. As to right, petitioner contends that a union by an inventor of process and apparatus claims, which are essentially the same invention, is given by the patent laws, and that rule 41, so far as it takes that right away, is repugnant to those laws, and invalid. As to remedy, that the decision of the primary examiner constituted a final decision upon the case, and petitioner was entitled to an appeal under the patent laws to the board of examiners-in-chief. The latter proposition depends upon the first. Assuming the right in an inventor as expressed in the first proposition, the primary examiner denied the right. True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty, or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. Section 4894, Rev. Stat. (U. S. Comp. Stat. 1901, p. 3384). A ruling having such effect must be considered as final and appealable. Whether,

however, to the examiners-in-chief or to the Commissioner, and **\*557** from the latter to the courts, we may postpone answering until we have considered the right of an inventor to join process and apparatus claims in one application.

Section 4886 of the Revised Statutes of the United States (U. S. Comp. Stat. 1901, p. 3382), provides as follows:

'Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, not known or used by others in this country before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.'

There is nothing in the language of the section which necessarily precludes the joinder of two or more inventions in the same application. But the section does distinguish inventions into arts (processes), machines, manufactures, and compositions of matter, and the earliest construction of the law denied the right of joinder. An exception, however, came to be made in cases of dependent and related inventions.

In *Hogg v. Emerson*, 6 How. 437, 12 L. ed. 505, it was said:

'The next objection is, that this description in the letters thus considered covers more than one patent and is therefore void.

'There seems to have been no good reason at first unless it be a fiscal one on the part of the government when issuing patents, why more than one in favor of the same inventor should not be embraced in one instrument, like more than one tract of land in one deed or patent for land. Phillips, Patents, 217.

'Each could be set out in separate articles or paragraphs, as different counts for different matters in libels in admiralty or declarations at common law, and the specifications could be made distinct for each, and equally clear.

'But to obtain more revenue, the public officers have generally **\*558** declined to issue letters for more than one patent described in them. Renouard, *Desbrevets D'Invention*, 293; Phillips, Patents, 218. The courts have been disposed to acquiesce in the practice as conducive to clearness and certainty. And if letters issue otherwise inadvertently, to hold them, as a general rule, null. But it is a well established exception that patents may be united, if two



or more, included in one set of letters, relate to a like subject, or are, in their nature or operation, connected together. Phillips Patents, 218, 219; *Barrett v. Hall*, 1 Mason, 447, Fed. Cas. No. 1,047; *Moody v. Fiske*, 2 Mason, 112, Fed. Cas. No. 9,745; *Wyeth v. Stone*, 1 Story, 273, Fed. Cas. No. 18,107.'

This language would seem to imply that not the statute, but the practice of the Patent Office, required separate applications for inventions, but the cases cited were explicit of the meaning of the statute. Mr. Justice Story, in *Wyeth v. Stone*, said:

'For, if different inventions might be joined in the same patent for entirely different purposes and objects, the patentee would be at liberty to join as many as he might choose, at his own mere pleasure, in one patent, which seems to be inconsistent with the language of the patent acts, which speak of the thing patented, and not of the things \*\*421 patented, and of a patent for invention, and not of a patent for inventions; and they direct a specific sum to be paid for each patent.'

But he confined the requirement to independent inventions, and his illustrations indicated that he meant by independent inventions not those which, though distinct, were 'for the same common purpose and auxiliary to the same common end.'

*Hogg v. Emerson* came to this court again and is reported in 11 How. 587, 13 L. ed. 824. Of one of the objections to the patent the court said:

'It is that the improvement thus described is for more than one invention, and that one set of letters patent for more than one invention is not tolerated by law.

'But grant that such is the result when two or more inventions are entirely separate and independent,--though this is doubtful on principle,--yet it is well settled, in the cases formerly cited, that a patent for more than one invention is not void if \*559 they are connected in their design and operation. This last is clearly the case here.'

Many other cases are to the same effect.

Can it be said that a process and an apparatus are inevitably so independent as never to be 'connected in their design and operation?' They may be completely independent. *Cochrane v. Deener*, 94 U. S. 780, 24 L. ed. 139. But they may be related. They may approach each other so nearly that it will be difficult to distinguish the process from the function of the apparatus. In such case the apparatus would be the dominant thing. But the dominance may be reversed and the process carry an exclusive right, no matter what apparatus may be devised to perform it. There is an illustration in the

*Telephone Cases*, 126 U. S. 1, 31 L. ed. 863, 8 Sup. Ct. Rep. 778. The claim passed upon in those cases was as follows:

'The method of, and apparatus for, transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations, similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth.'

The claim was held to refer to the art described, and the means of making it useful. The court observed:

'Other inventors may compete with him for the ways of giving effect to the discovery, but the new art he has found will belong to him and those claiming under him during the life of his patent.'

A distinction between the process and the means employed for using it was recognized. It was said:

'The patent for the art does not necessarily involve a patent for the particular means employed for using it. Indeed, the mention of any means, in the specification or descriptive portion of the patent, is only necessary to show that the art can be used; for it is only useful arts--arts which may be used to advantage--that can be made the subject of a patent.'

The patent was sustained. It was not attacked because it embraced independent inventions. The fact is not without \*560 force. Considering the ability of counsel engaged and the division of the court in opinion, it is a proper inference that no tenable objection to the patent was overlooked.

It is said by Robinson, in his work on Patents, that 'special rules which govern the joinder of arts or processes with each other or with related inventions of a different class, are more stringent in the Patent Office than in the courts.' 2 Robinson, Patents, § 473. And the author deduces the conclusion that under the rules of the Patent Office a process cannot be 'joined with the apparatus that performs it, nor either of these with the product in which they result, unless they are to such an extent inseparable that the existence of some one of them is dependent upon that of the others.' But rule 41 precludes even this.

If there is a divergence of views between the courts and the Patent Office, and the divergence proceeds from a different interpretation of the statute, the views of the courts ought to prevail. If the courts, however, have only recognized and enforced the exercise of a discretion of the Patent Office, the question occurs, What is the extent of such discretion, and can it be expressed and fixed in an inflexible rule such as rule 41? In *Bennet v. Fowler*, 8 Wall. 445, 19 L. ed. 431, a discretion in the Patent Office was recognized. The question arose upon the validity of two reissued patents for improvements, which 'had been embraced in one, in the

original patent.' The court said:

'It may be that if the improvements set forth in both specifications had been incorporated into one patent, the patentee taking care to protect himself as to all his improvements by proper and several claims, it would have been sufficient. It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the Patent Office. It is often a nice and perplexing question.'

Some discretion is not an unlimited discretion, and if the \*561 discretion be not unlimited it is reviewable. In other words, the statute gives the right to join inventions in one application in cases where the inventions are related, and it cannot be denied \*\*422 by a hard and fixed rule which prevents such joinder in all cases. Such a rule is not the exercise of discretion; it is a determination not to hear. No inventor can reach the point of invoking the discretion of the Patent Office. He is notified in advance that he will not be heard, no matter what he might be able to show. His right is denied, therefore; not regulated. Such is the necessary effect of rule 41, as amended.

Without that rule the action of the Patent Office can be accommodated to the character of inventions, and discretion can be exercised, and when exercised, we may say in passing, except in cases of clear abuse, the courts will not review it. But the rule as amended, as we have said, precludes the exercise of any judgment, and compels the separation of claims for a process and claims for its apparatus, however related or connected they may be. And the right denied is substantial. Counsel for petitioner have explained that right by the embarrassments caused by its denial, one of which is that, by disclosing the apparatus in his application for the process, he might lose the right to and a patent for the apparatus; and to sustain that view *James v. Campbell*, 104 U. S. 356, 26 L. ed. 786, is cited. We are not prepared to admit such consequences nor that *James v. Campbell* so decides. If the classification of the statute makes a distinction between the different kinds of inventions--between a process and an apparatus--and requires or permits a separate application for each, it would seem to follow irresistibly that an application and patent for one would not preclude an application and patent for the other, and the order of the application could not affect the right which the law confers. *James v. Campbell* was a case of reissued patent, and by express provision of the statute as to reissued patents no new matter can be introduced in them. In other words, the reissue is to perfect, not to enlarge, the prior patent. Whether the principle of the case applies to \*562 related as well as to independent inventions is not clear from its language. The court said:

'Where a new process produces a new substance, the invention of the process is the same as the invention of the substance, and a patent for the one may be reissued so as to include both, as was done in the case of Goodyear's vulcanized rubber patent. But a process, and a machine for applying the process are not necessarily one and the same invention.'

The facts of the case did not call for a more definite ruling. The original patent was for a device for postmarking and canceling postage stamps by a single blow. The reissued patent claimed the act of marking and cancelation, and it was observed by the court:

'The process or act of making a postmark and canceling a postage stamp by a single blow or operation, as a subject of invention, is a totally different thing in the patent law from a stamp constructed for performing that process.'

But without attempting to enlarge the case and extend it to more intimately related inventions, it is enough now to say that there is nothing in the case which decides that if the process had been claimed in an independent application it (the process) would have been adjudged to have been dedicated to the public by the other patent. There is language indicating the contrary. It was said:

'If he [the patentee] was the author of any other invention than that which he specifically describes and claims, though he might have asked to have it patented at the same time and in the same patent, yet if he has not done so, and afterwards desires to secure it, he is bound to make a new and distinct application for that purpose, and make it the subject of a new and different patent.'

The case, however, indicates what embarrassment and peril of rights may be caused by a hard and fixed rule regarding the separation of related inventions. See also *Mosler Safe & Lock Co. v. Mosler*, 127 U. S. 354, 32 L. ed. 182, 8 Sup. Ct. Rep. 1148, and *Miller v. Eagle Mfg. Co.* 151 U. S. 186, 38 L. ed. 121, 14 Sup. Ct. Rep. 310.

\*563 The Patent Office has not been consistent in its views in regard to the division of inventions. At times convenience of administration has seemed to be of greatest concern; at other times more anxiety has been shown for the rights of inventors. The policy of the office has been denominated that of 'battledore and shuttlecock,' and rule 41 as it now exists was enacted to give simplicity and uniformity to the practice of the office. Its enactment was attempted to be justified by the assumption that the patent laws gave to the office a discretion to permit or deny a joinder of inventions. But, as we have already said, to establish a rule applicable to all cases is not to exercise discretion. Such a rule ignores the differences which invoke discretion, and which can alone justify its exercise, and we are of opinion therefore

that rule 41 is an invalid regulation.

3. Having settled the right of appellant, we may now return to the consideration of his remedy. Respondent contends:

'It is fundamental that mandamus will not issue against a public officer, except to compel the performance of some plain, \*\*423 clear, ministerial duty, and will not issue to control his discretion.'

And it is further contended that respondent has acted, and, having acted, cannot be required to refer the case to a lower tribunal in his office. To sustain the contention *Holloway v. Whiteley*, 4 Wall. 522, 18 L. ed. 335, is cited.

The unity of the inventions claimed by petitioner in the case at bar we may assume. It is not denied by respondent. Petitioner had, therefore, the right to join them in one application. The denial of this right by the primary examiner was a rejection of the application and entitled petitioner to an appeal to the examiners-in-chief, under § 4909 of the Revised Statutes (U. S. Comp. Stat. 1901, p. 3390). That sections provides:

'Every applicant for a patent, . . . any of the claims of which have been twice rejected, . . . may appeal from the decision of the primary examiner to the board of examiners-in-chief; . . .'

\*564 The § 482 (U. S. Comp. Stat. 1901, p. 272), provides:

'The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be, on the written petition of the appellant, to revise and determine upon the validity of the adverse decisions of examiners upon applications for patents, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them.'

The procedure on appeal is provided for by the rules of the Patent Office. It is taken by filing a petition praying an appeal with the primary examiner, setting forth the reasons upon which the appeal is based, and it is made the duty of the examiner, five days before the date of hearing, to furnish the appellate tribunal and the appellant with a statement of the grounds of his decision. A petition praying an appeal was filed, but the primary examiner refused to answer the appeal, and the defendant in error also refused to direct him to answer it. It is manifest that if an appeal cannot be compelled from the decision of the primary examiner, an applicant is entirely without remedy. And respondent has asserted that extreme. In *Ex parte Frasch*, 20 App. D. C. 298, the court of appeals of the District of Columbia was persuaded that an appeal was not the proper remedy. In the

case at bar it is contended that mandamus is not the proper one. One or the other must be. A suggestion made is that the inventor must await a decision on the merits, meaning by merits 'lack of invention, novelty, or utility,' as expressed in rule 133. But after waiting he would encounter the arbitrary requirement of rule 41. Besides, what would there be to review if the order of the primary examiner were complied with and the claims put into separate applications? There are some observations in *Holloway v. Whiteley*, which may be quoted. Whitely claimed to be the assignee of a patent, and filed an application for a reissue. The Commissioner declined to entertain it on the ground that Whitely was only assignee of an interest, and not of the entire patent. He also \*565 declined to allow an appeal to be taken from his decision. The supreme court of the District of Columbia awarded a peremptory writ of mandamus commanding the Commissioner to refer the application to the proper examiner, or otherwise examine or cause it to be examined according to law. Error was prosecuted to this court. Under the act of 1836 [5 Stat. at L. p. 117, chap. 357], it was provided that if the Commissioner decided adversely to an applicant for a patent an appeal could be taken to the board of examiners, and by the act of 1837 [5 Stat. at L. 191, chap. 45], that remedy was given to an applicant for a reissue of a patent, and the question in the case was whether that remedy should have been pursued. In other words, whether the remedy was by appeal or mandamus. It was decided that appeal was the remedy. Singularly enough, the Commissioner, in answer to the rule, took the position that the application was not before him because it had not been filed. The court said if that were so 'mandamus would clearly lie to compel the Commissioner to receive it. It was his first duty to receive the application, whatever he might do subsequently. Without this initial step there could be no examination, and, indeed, no rightful knowledge of the subject on his part. Examination and the exercise of judgment, with their proper fruit, were to follow, and they did follow.'

And so the exercise of judgment might follow a hearing of the application under review. It was the duty of the primary examiner to accord a hearing or, refusing to do so, to grant an appeal. It was the duty of the Commissioner to compel the appeal. The Commissioner of Patents is primarily charged with granting and issuing patents. Applications for patents are made to him (§ 4888, Revised Statutes, U. S. Comp. Stat. 1901, p. 3383), and his superintendence should be exercised to secure the rights which the statutes confer on inventors. The first of those rights is a hearing. If that be denied other rights cannot accrue.

The Commissioner justifies his decision by the rules of the Patent Office and a long practice under them. If there is inconsistency between the rules and statute, the latter \*\*424 must prevail. \*566 But the primary examiner did not follow

(Cite as: 192 U.S. 543, 24 S.Ct. 416)

the rules. The rules provide that if appeal be regular *in form* (italics ours) he shall, within five days of the filing thereof, furnish the examiners-in-chief with a written statement of the grounds of his decision on all of the points involved in the appeal, with copies of the rejected claims and with the references applicable thereto. If he decide that the appeal is not regular in form, a petition from such decision may be made directly to the Commissioner. The regularity of the appeal in form is not questioned in the case at bar, and it was the duty of the examiner to answer the appeal by furnishing the examiners-in-chief the statement provided for in rule 135. A petition to the Commissioner was not necessary except to make the examiner to perform his duty.

4. We do not think that petitioner was estopped from insisting upon his application by proceeding with the interference with Duncan after the examiner's letter of December 15, 1899. It would be pressing mere order of procedure and the convenience of the Patent Office too far to give them such result under the circumstances.

*The judgment of the Court of Appeals is therefore reversed*, with directions to reverse that of the Supreme Court, and direct the Supreme Court to grant the writ of mandamus as prayed for.

FN<<dagger>> 1. The herein-described method of measuring alternating electric currents, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetism and adapted to actuate a rotatable armature in a motor meter arranged within the energizing coils producing said lines of magnetization.

2. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization, and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

3. The herein-described method of actuating a single-phase alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

4. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines and subjecting an armature to the inductive action of said field.

5. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces being proportional to the current and the other two to the electro-motive force, and subjecting an armature to the inductive action of said field.

6. The herein-described method of actuating an alternating-current motor meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, the several magneto-motive forces being so proportioned and related to each other that the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.

7. In a Watt meter for alternating electric currents, means for producing a magnetic flux proportional to the current and varying in phase therewith, means for producing a second magnetic flux proportional to the electromotive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux, and of such magnitude and phase that the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

8. The combination in an electro motor of a field-magnet system and means for inducing therein magnetic fluxes of three phases, one a flux due to a series coil and proportional to the current, a second flux due to a shunt potential coil and lagging behind the electro-motive force, and a third flux lagging behind said second flux and having a fixed angular relation thereto such that the resultant of the second and third fluxes is dephased by substantially the complement of the angle of lag from the flux due to the series coil.

9. The combination in a recording electric meter of a field-magnet system acting on the armature and having a plurality of intersecting magnetic axes, means for inducing along one of said magnetic axes a flux proportional to the current and varying in phase therewith, and means for inducing along the other magnetic axes a plurality of other fluxes dependent upon the potential of the metered circuit, which lag behind the electro-motive force by different amounts and act upon the armature at different points, said fluxes being so proportioned in value and phase that their joint action upon the armature will enable the meter to register the true

energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

10. In a Watt meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force, of such a magnitude and phase that the joint action of the several fluxes upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

11. In a meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axes an auxiliary magnetic flux also proportional to the electro-motive force and of such magnitude and phase that the joint action of the two potential fluxes upon the armature will produce a torque sufficient to overcome the static friction of the meter.

12. In a single-phase alternating current meter, the combination of a field-magnet system having three intersecting magnetic axes, a field coil in which the current phase varies as the conditions of the circuit change, producing a magnetization along one magnetic axis, a potential coil producing a magnetization along another magnetic axis, a reactance device in series with said potential coil for lagging the current behind the electro-motive force, and a second potential coil depending for its current upon the first potential coil, producing a magnetization along the third magnetic axis; the two potential coils conveying currents which differ in phase from each other, and each generating a flux which acts upon the armature at a point removed from the point at which the flux due to the other potential coil acts upon the armature.

13. In an electric meter, the combination of a multipolar field-magnet structure having three magnetic axes, current coils mounted upon some of the field poles and producing a magnetization

along one of said magnetic axes, potential coils mounted upon other field poles and producing a magnetization along another one of said magnetic axes, and other potential coils mounted upon a portion only of the lastnamed field poles, or some of them, and producing a magnetization along the third magnetic axis, and an armature acted upon by the flux induced by the field coils.

24 S.Ct. 416, 192 U.S. 543, 48 L.Ed. 555

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